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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,502	09/25/2001	Tetsuharu Tanaka	107348-00119	5501

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EXAMINER

BOYD, JENNIFER A

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,502

Applicant(s)

TANAKA ET AL.

Examiner

Jennifer A Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is rejected due to its dependency on independent claim 1.

Claim 1 is indefinite because the Examiner is unsure of the meaning of “(inclusive)”. Does the Applicant mean that the range for the amount of pigment present in the resin includes 0.3 and 10 parts along with the amounts within that range? It should be noted that anytime an Applicant states a range, the Examiner will include those numbers within the range. Therefore, if this is what is intended by the Applicant, it is suggested to remove the term “(inclusive)”.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nelson (US 6,194,329).

Nelson relates to urethane coated and laminated fabrics which meet predetermined levels

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of opacity, ultra-violet protection, cold weather crack resistance, abrasion resistance and infrared reflectance (column 1, lines 15 – 25).

As to claims 1 and 6, Nelson teaches a dyed textile substrate and three coats of pigmented polyurethane having varying compositions (Abstract). The substrate layer 12 can comprise a knitted material, equated to Applicant's "base knitted fabric" (column 4, lines 16 – 34). The substrate has a base coating 14 applied to it, which is designed to assist in tying the subsequent coating or laminate layers to the substrate (column 4, lines 35 – 40). A midcoat 16, equated to Applicant's "lower layer body", is applied to the base coating 14, preferably at a thickness on the order of about 0.5 and 1.0 ml. The midcoat contains about 13 – 50% polyester polyurethane (a synthetic resin), 1 - 2% antimony trioxide, about 3 – 5% decabromodiphenyl oxide, about 5 - 15% pigment, about 0.05 - 0.1% biocide and about 40 – 65% solvent (column 4, lines 65 – 67 and column 5, lines 1 – 3). The pigment in the midcoat can be organic carbon black (column 4, lines 58 – 67). A top coat 18, equated to Applicant's "upper skin body", is applied to the midcoat. The top coat contains enough pigment to meet specified spectral reflectance properties. The top coat desirably includes 13 – 39% polyester polyurethane, about 2 – 5% antimony trioxide, about 10 - 15% decabromodiphenyl oxide, about 6 – 12% pigment, about 0.05 – 0.1% biocide and about 45 – 60% solvent (column 5, lines 5 – 16). The pigment can be inorganic titanium oxide, which has a high refractive index (column 4, lines 64 – 65).

As to claims 1 and 11, it should be noted that knit fabrics do not have smooth surfaces due to the entanglements of the structure. Therefore, when a coating is applied to the surface of the fabric, the coating will contour the irregularities of the knitted fabric creating the Applicant's recesses and projections. Although Nelson does not explicitly teach the claimed height of the

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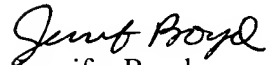
projections is 0.05 mm or more as required by claim 1 and is 0.35 mm or less as required by claim 11, it is reasonable to presume that claimed height of the projections is 0.05 mm or more as required by claim 1 and is 0.35 mm or less as required by claim 11 is inherent to Nelson. Support for said presumption is found in the use of like materials (i.e. a resin coated knitted fabric) which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of height of the projections is 0.05 mm or more as required by claim 1 and is 0.35 mm or less as required by claim 11 would obviously have been present once the Nelson product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jennifer Boyd
April 3, 2003